



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,521	11/14/2001	Avi J. Ashkenazi	P2730P1C6	4963
35489	7590	03/23/2004	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP 275 MIDDLEFIELD ROAD MENLO PARK, CO 94025-3506			KAUFMAN, CLAIRE M	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,521

Applicant(s)

ASHKENAZI ET AL.

Examiner

Claire M. Kaufman

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 119-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 119-124 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/28/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: sequence comparison

Art Unit: 1646

DETAILED ACTION

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 119 and 124 and dependent claims 120-123 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 119 and 124 are indefinite because claim 119 recites "binds" and claim 124 recites "specifically binds". Absent a definition of "specific binding", it is not clear what the difference between the two claims is and what each claim is meant to encompass, given that antibody binding is determined by the variable regions structure and is a "specific" event.

Priority

Priority application 09/380,137 and earlier filed priority applications do *not* meet the requirements of 35 U.S.C. § 112, first paragraph. Because there was no function associated with PRO1282 and the skilled artisan would not have known how to use it, the prior application also does not meet those requirements and, therefore, is unavailable under 35 U.S.C. § 120. Note that even if priority were granted to the earliest filed priority application 60/097,979, the art rejection below would remain under 35 UCS 102(e).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1646

Claims 119-130 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,225,085.

US 6,225,085 teaches a LRSG (leucine-rich surface glycoprotein) of SEQ ID NO:2 which is identical to SEQ ID NO:52 of the instant application (see attached SEQUENCE COMPARISON). Also disclosed are anti-LRSG antibodies and well known methods of making them, including monoclonal (*e.g.* col. 22, lines 62-63, and col. 23, line 37, through col. 24, line 32), chimeric, humanized (col. 24, lines 33-56), labeled (col. 25, lines 2-17) antibodies and antibody fragments (col. 22, lines 59-62).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (571)272-0873. Dr. Kaufman can generally be reached Monday, Tuesday and Thursday from 8:30AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at (571)272-0871.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Official papers filed by fax should be directed to (703) 872-9306. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Claire M. Kaufman, Ph.D.



Patent Examiner, Art Unit 1646

March 17, 2004

SEQUENCE COMPARISON OF SEQ ID NO:52 WITH US 6,225,085

; Sequence 2, Application US/09063950C
 ; Patent No. 6225085
 ; GENERAL INFORMATION:
 ; APPLICANT: Holtzman, Douglas A.
 ; TITLE OF INVENTION: NOVEL LRSG PROTEIN AND NUCLEIC ACID MOLECULES AND USES
 ; TITLE OF INVENTION: THEREFOR
 ; CURRENT APPLICATION NUMBER: US/09/063,950C
 ; CURRENT FILING DATE: 1998-04-21
 ; SEQ ID NO 2
 ; LENGTH: 673
 ; TYPE: PRT
 ; ORGANISM: Homo sapiens
 US-09-063-950-2

Query Match 100.0%; Score 3520; DB 3; Length 673;
 Best Local Similarity 100.0%; Pred. No. 5.8e-249;
 Matches 673; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

```

Qy      1 MCSRVPLLLPLLLLLALGPGVGCGPCSGCQCSQPQTVFCTARQGTTVPRDVPPDVTGLYVF 60
        |||
Db      1 MCSRVPLLLPLLLLLALGPGVGCGPCSGCQCSQPQTVFCTARQGTTVPRDVPPDVTGLYVF 60

Qy      61 ENGITMLDAGSFAGLPGLQLLDLSQNQIASLPSGVFQPLANLSNLDLTANRLHEITNETF 120
        |||
Db      61 ENGITMLDAGSFAGLPGLQLLDLSQNQIASLPSGVFQPLANLSNLDLTANRLHEITNETF 120

Qy      121 RGLRRRLERLYLGKNRIRHIQPGAFDTLDRLLELKLQDNELRALPPLRLPRLLLDLSHNS 180
        |||
Db      121 RGLRRRLERLYLGKNRIRHIQPGAFDTLDRLLELKLQDNELRALPPLRLPRLLLDLSHNS 180

Qy      181 LLALEPGILDANVEALRLAGLGQLQDDEGLFSRLRNLDLSDNQLERVPPVIRGLRG 240
        |||
Db      181 LLALEPGILDANVEALRLAGLGQLQDDEGLFSRLRNLDLSDNQLERVPPVIRGLRG 240

Qy      241 LTRLRLAGNTRIAQLRPEDLAGLAALQELDVSNSLSQALPGDLSGLFPRRLRLAAARNFF 300
        |||
Db      241 LTRLRLAGNTRIAQLRPEDLAGLAALQELDVSNSLSQALPGDLSGLFPRRLRLAAARNFF 300

Qy      301 NCVCPLSWFGPWWRESHVTLASPEETRCHFFPPKNAGRLLLELDYADFGCPATTTTATVPT 360
        |||
Db      301 NCVCPLSWFGPWWRESHVTLASPEETRCHFFPPKNAGRLLLELDYADFGCPATTTTATVPT 360

Qy      361 TRPVVREPTALSSSLAPTWLSPTAPATEAPSPSTAPPTVGPVPQDCPSTCLNGGTC 420
        |||
Db      361 TRPVVREPTALSSSLAPTWLSPTAPATEAPSPSTAPPTVGPVPQDCPSTCLNGGTC 420

Qy      421 HLGTRHHLACLCEPGEFTGLYCESQMGGTRPSPTPTVTPRPPRSLTGLIEPVSPTSRLRVGL 480
        |||
Db      421 HLGTRHHLACLCEPGEFTGLYCESQMGGTRPSPTPTVTPRPPRSLTGLIEPVSPTSRLRVGL 480

Qy      481 QRYLQGSSVQLRSLRLTYRNLSPGDKRLVTLRLPASLAEYTVTLRPNATYSVCMPLGP 540
        |||
Db      481 QRYLQGSSVQLRSLRLTYRNLSPGDKRLVTLRLPASLAEYTVTLRPNATYSVCMPLGP 540

```

Qy	541	GRVPEGEEACGEAHTPPAVHSNHAFVTQAREGNLPLLIAPALAAVLLAALAAVGAAYCVR	600
Db	541	GRVPEGEEACGEAHTPPAVHSNHAFVTQAREGNLPLLIAPALAAVLLAALAAVGAAYCVR	600
Qy	601	RGRAAAAAQDKGVGPGAGPLELEGVKVPLEPGPKATEGGGEALPSGSECEVPLMGFP	660
Db	601	RGRAAAAAQDKGVGPGAGPLELEGVKVPLEPGPKATEGGGEALPSGSECEVPLMGFP	660
Qy	661	PGLQSPLHAKPYI	673
Db	661	PGLQSPLHAKPYI	673